

Application No. 10/053756
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Amendment
Attorney Docket No. S63.2B-10056-US01

Remarks

This Amendment is in response to the Office Action dated September 14, 2004, wherein claims 1-3 and 8-19 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. 6,254,632 to Wu et al (hereinafter: Wu); and claims 1-21 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. 6,613,079 to Wolinsky et al (hereinafter: Wolinsky) in view of U.S. 6,379,379 to Wang et al (hereinafter: Wang).

The following comments are presented in the same order and with headings and paragraph numbers corresponding to the Office Action.

Claim Rejections – 35 USC §102

1-2. In the Office Action, claims 1-3 and 8-19 were rejected under §102(e) as being anticipated by Wu. It is asserted in the Office Action that Wu discloses a stent having all of the limitations presently claimed. More specifically, the Office Action characterizes features 200, 310 and 320 of Wu as being equivalent in structure to the "bumper" recited in the instant claims.

In Wu features referred to as craters (200) are provided with a protruding lip 204 that extends above the plane of the stent (column 5, lines 10-11). The craters of Wu are intended to provide a variety of functions such as retaining a covering (column 2, lines 53-58), hold glue in place for attachment to a cover (column 2, lines 58-60), or to delivery a therapeutic agent directly into the lumen wall (column 2, lines 60-63). In all of the various embodiments described and shown however, the craters are positioned on the *outer surface* 114 of the stent (column 4, line 66 to column 5, line 2; column 6, lines 13-17; etc.)

Wu makes it clear that the craters are positioned on the external or outer surface of the stent. While such craters may certainly come into contact with a coating or therapeutic substance (column 6, lines 18-27) the external position of the craters makes it structurally and functionally impossible for the craters to reduce or prevent contact between a substance coated on at least one strut of the stent and an adjacent strut when the stent is in the reduced state, as instant claims 1 and 20 describe.

Because Wu does not teach or suggest all of the elements of the instant claims the rejection is respectfully overcome.

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Claim Rejections – 35 USC §103

3-4. In the Office Action claims 1-21 were rejected under §103(a) as being obvious over Wolinsky in view of Wang.

Though the Office Action asserts that Wolinsky discloses “a stent having all of the limitations of the claims except for the presence of a substance coating”, the Office Action does not point out with any specificity the basis for this assertion. Applicants presume however, that the rejection is based substantially on the embodiment depicted in FIG. 7 of Wolinsky, wherein protrusions 327a and 327b protrude off of their respective struts and face towards one another.

The protrusions described in Wolinsky are described as defining the point at which the struts first abut when the stent is compressed. This differs from other embodiments wherein the point of initial contact is in the primary bend 322. Wolinsky uses FIG. 7 to illustrate that by removing the initial contact point from the primary bend the minimum bending radius of the primary bend is limited, thereby reducing the maximum bending stresses at the primary bends that is associated with compression of the stent (column 10, lines 30-49).

Nowhere does Wolinsky teach or suggest that the protrusions are constructed and arranged to reduce or prevent contact between a therapeutic substance on a strut and an adjacent strut when the stent is in the reduced state as the instant claims describe. Rather, the protrusions of Wolinsky illustrate the point of “first contact” between the struts. Wolinsky provides no disclosure that would suggest that the protrusions reduce or prevent contact as the bumpers of the instant claims do.

In light of this, assuming *arguendo* that some motivation exists to combine the stent of Wolinsky with the coatings of Wang it is clear that such a coating present on the struts such as is described in Wang would be adversely affected by the contact of the protrusions as well as any subsequent contact between other portions of the adjacent struts. As to the requisite motivation, one of ordinary skill in the art would not seek to apply the coatings of Wang to a stent which has a structure that adversely affects the performance of the coating when the stent is compressed, as appears to be the case in Wolinsky.

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It is only when the proposed combination of Wolinsky and Wang are viewed through the lens of hindsight afforded by the present Application is any motivation to combine provided. It is well recognized that such use of hindsight is impermissible. (*W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Conclusion

In light of the above claims 1-21 are believed to be in condition for allowance. Favorable consideration and prompt action to that effect are sincerely requested.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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